

REMARKS

Applicants acknowledge receipt of the Office Action mailed August 18, 2008.

In the Office Action, the Examiner rejected claims 6-8 under 35 U.S.C. § 103(a), as being unpatentable over Jin et al (U.S. Patent No. 7,112,974).

In this Amendment, Applicants amend claim 6, and add new claim 10. Upon entry of this Amendment, claims 6-8 and 10 will be pending. Of these claims, claim 6 and claim 10 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claim 6, and the addition of claim 10. No new matter has been introduced.

Applicants respectfully submit this Amendment in response to the rejection above and request reconsideration for the following reasons.

I. 35 U.S.C. § 103(a) REJECTION

The Action rejects claims 6-8 under 35 U.S.C. § 103(a) in light of Jin as allegedly being obvious to a person having ordinary skill in the art. A rejection under 35 U.S.C. § 103(a) requires that "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." The amended claim 6 recites an invention that has structural limitations significantly different than those found in Jin or any of the additionally cited art. The structural limitation of a contact surface "substantially parallel to the surface of the electrode" is not satisfied by Jin, and is not suggested by the additionally cited prior art. This limitation would not have been obvious to a person having ordinary skill in the art.

With regard to the limitation of “to function as a stopper for the tip portions when the tip portions penetrate the oxide film to reach the electrode”, the Action cites *Ex Parte Masham*, 2 U.S.P.Q. F.2d 1647 (1987) as holding “that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.”

In amended claim 6, the contact portion has a contact surface which “is formed substantially parallel to the surface of the electrode”. Jin specifically fails to disclose or suggest the contact surface as recited in claim 6. Therefore, amended claim 6 is structurally distinguishable from Jin. The prior art apparatus does not satisfy the claimed structural limitations “to function as a stopper for the tip portions when the tip portions penetrate the oxide film to reach the electrode,” and *Ex Parte Masham*, 2 U.S.P.Q. F.2d 1647 is not held.

According to the present invention, because “the contact surface of the contact portion functions as a stopper, it is possible to surely and stably inspect the electric characteristic of the IC chip without damaging the electrode pad by the probe (paragraph 0024, lines 17-20).” The contact portion (12) of Jin cannot function as a stopper; therefore, such an effect cannot be obtained in Jin. The additional citations also do not suggest or teach the claimed structure or effect. It would not have been obvious to one of ordinary skill in the art to modify Jin in a fashion that would teach the limitations of claim 6.

Amended claim 6 should therefore not be rejected. Claims 7 and 8 depend on amended claim 6 and should likewise be allowable.

II. NEW CLAIMS

New claim 10 recites an invention including characteristic features of the invention recited in amended claim 6. Therefore, the inventions of new claim 10 and amended claim 6 satisfy the requirement for unity of inventions, and new claim 10 should be allowable.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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